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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	[illegible]

[illegible]
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EXAMINER	
SHERRER	
ART UNIT	**PAPER NUMBER**
1761	9

DATE MAILED: 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/423,665	Falconnier et al
Examiner	**Art Unit**
Curtis E. Sherrer	1761

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) X Responsive to communication(s) filed on *May 14, 2001* .

2a) X This action is **FINAL.** 2b) ☐ This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) X Claim(s) *20-45* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) X Claim(s) *20-45* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s).

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Part III DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

2. Again, claims 20-45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a beverage that has improved solubility (non-cloudy) of anethole, does not reasonably provide enablement for beverages that do not rely on the use of a micro or submicron emulsion (see page 4, bottom). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Merely because the claims refer to said recitation does not enable the invention. Further, in the applicants' instant response, much of the patentability is placed on this limitation and therefore, a proper showing of enablement is required.

3. Claims 20-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have amended the claims to include the terms "

CS. 10/26/01

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is indefinite because the scope of the phrases "acceptable as an additive" and "visible solubility" is unknown.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 20-27, and 30-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brun et al. (U.S. Pat. No. 4,944,956) for the reasons set forth in the last Office Action.

9. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brun et al. in view of Kirk (U.S. Pat. No. 4,966,779) for the reasons set forth in the last Office Action.

Response to Arguments

10. Applicant's arguments filed 05/14/01 have been fully considered but they are not persuasive.

11. Applicants argue that the prior art does not teach a submicron or emulsion or microemulsion (the secondary reference Kirk teaches about 0.5 microns) required to produce a beverage with a clear aspect, i.e., not cloudy. They state that a particle size of 0.1 micron "is required, i.e., in order for the beverage to have a clear aspect." In light of this comment, applicant is required to narrow the claims so as to be limited to this size of particle.

12. On the other hand, said statement, at this point in the prosecution, appears to be based on opinion and is therefore given little weight. It is also noted that 0.5 microns is "submicron," i.e., less than a micron. Further yet, the cited range is actually "about 0.5 microns" and would therefore include values below 0.5 microns. Further yet, the rejection is based on obviousness and it would have been obvious to those of ordinary skill in the art to optimize the particle size as it is a result effective variable. It is also noted that only claim 24 is directed to a clear beverage and claim 38 is directed to a cloudy beverage.

13. The third paragraph of applicants response on page 8, is incomprehensible and therefore is not understood and it is difficult to comment on its subject matter. It appears that applicants are asserting that the only way to obtain the claimed emulsion is by using the claimed means, i.e., "high pressure homogenization or by an appropriate mixer at high speed." As found above, the instant invention is not enabled due to the lack of disclosure on how to practice the invention.

The disclosed means are broad (and indefinite) and, due to applicants reliance on these means to assert patentability,

14. Lastly, Applicants cited to numerous case law concerning the proper basis for an obviousness rejection. This law is good. Yet, applicants fail to cite and comment on the previously cited case law, *In re Levin*, which provides the proper motivational basis for the instant obviousness rejection.

Conclusion

15. No claim is allowed.

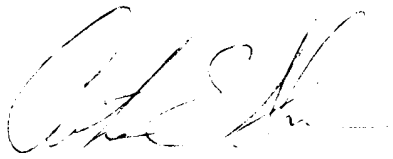
16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

18. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
July 20, 2001